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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,744	12/20/2001	Joseph C. Walsh	PP 5.71(c)	4239

7590 02/21/2003

Michael A. Goodwin, Esq.  
Klaas, Law, O'Meara & Malkin, P.C.  
Suite 2225  
1999 Broadway  
Denver, CO 80202

EXAMINER

TAWFIK, SAMEH

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 02/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/027,744

Applicant(s)

WALSH, JOSEPH C. 3

Examiner

Sameh H. Tawfik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-94 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 20-94 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 20-28, drawn to a process for making a dispensing assembly, classified in class 493, subclass 87.
- II. Claims 29-35, drawn to a process for providing a dispensing spout, classified in class 493, subclass 86.
- III. Claims 36-66, 85-88, 91, 92, and 94, drawn to dispensing assembly, classified in class 206.
- IV. Claim 67, drawn to a process for making a dispensing assembly, classified in class 493, subclass 51.
- IV. Claims 68-72, drawn to a process for making a dispensing assembly, classified in class 493, subclass 55.
- VI. Claims 73-76, drawn to a process for making a dispensing assembly, classified in class 493, subclass 160.
- VII. Claims 77 and 78, drawn to a process for making a pour spout assembly, classified in class 493, subclass 59.
- VIII. Claims 79 and 80, drawn to an apparatus for providing a carton, classified in class 493, subclass 80.
- IX. Claims 81-83, drawn to an apparatus for providing a carton with a dispensing assembly, classified in class 493, subclass 76.

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- IIX. Claim 84, drawn to an apparatus for providing a carton with a dispensing opening, classified in class 493, subclass 93.
- XI. Claim 89, drawn to a process for making a dispensing, classified in class 493, subclass 94.
- XII. Claim 90, drawn to an apparatus for providing a carton, classified in class 493, subclass 98.
- XIII. Claim 93, drawn to a process for preparing a dispensing assembly, classified in class 493, subclass 100.

The inventions are distinct, each from the other because of the following reasons:

Inventions Groups (I, IV-VII, XI-XIII) and Groups (VIII-IX) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by hand and/or another materially different apparatus such as one with no means for providing a carton, means to bring the liner, nor means to bond the liner.

Inventions Groups (I, IV-VII, XI-XIII) and Group III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make other and materially

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different product such as one with the liner means been bonding to the front panel whereby upon initial opening of the pour spout means that portion of the liner bonded to the front panel separates from the liner means.

Inventions Groups (VIII-IIX) and Group III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product as claimed can be made by another and materially different apparatus such as one with no means for providing a carton, means to bring the liner, and/or means to bond the liner.

Inventions Group II and Groups (I and III-XIII) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions as defined by the claims of Group II neither recites nor requires the inventions as defined by the claims of Groups (I and III-XIII).

Inventions Groups (VIII and IIX) and Group IX are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require to have means for providing a carton having a separate liner therein and means to promote bonding

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between the liner and the front panel. The subcombination has separate utility such as means for providing a carton having a separate liner therein and means to promote bonding between the liner and the front panel.

Inventions Groups (VIII and IX) and Group IIX are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require to have means for providing a pour spout having side panels and a front panel and a fitment having a cut-cut defining a dispensing opening, upper and lower margin portions. The subcombination has separate utility such as means for providing a pour spout having side panels and a front panel and a fitment having a cut-cut defining a dispensing opening, upper and lower margin portions.

Inventions Groups (I, IV-VII, XI, and XII) and Group XIII are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require to have the step of providing bonding energy to the bonding member to bond the liner to the front panel and create and to form a weakened tear line. The subcombination has separate utility such as the

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step of providing bonding energy to the bonding member to bond the liner to the front panel and create and to form a weakened tear line.

Inventions Groups (I, IV-VII, and XI) and Group XII are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require to have the step of means for bonding the liner to the front panel whereby upon initial opening of the pour spout, that portion of the liner bonded to the front panel separates from the liner providing access to the interior thereof. The subcombination has separate utility such as the step of means for bonding the liner to the front panel whereby upon initial opening of the pour spout, that portion of the liner bonded to the front panel separates from the liner providing access to the interior thereof.

Inventions Groups (I, IV-VII) and Group XI are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require to have the step of bonding the liner to the front panel wherein the front panel is provided with means to promote bonding to the liner and bonding energy is delivered to the interface between the front

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panel and the liner. The subcombination has separate utility such as the step of bonding the liner to the front panel wherein the front panel is provided with means to promote bonding to the liner and bonding energy is delivered to the interface between the front panel and the liner.

Inventions Groups (I and IV-VI) and Group VII are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require to have the step of forming a pour spout having side panels and front panel pivoting between open and closed positions about the base of the front panel and the front panel being integral with the lower margin portion of the fitment. The subcombination has separate utility such as the step of forming a pour spout having side panels and front panel pivoting between open and closed positions about the base of the front panel and the front panel being integral with the lower margin portion of the fitment.

Inventions Groups (I, IV, and IIV) and Group VI are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require to have the step of providing a carton having a fitment having a cut-out defining a dispensing opening,



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nor the step of attaching the fitment to the interior of the one wall. The subcombination has separate utility such as the step of providing a carton having a fitment having a cut-out defining a dispensing opening, and the step of attaching the fitment to the interior of the one wall.

Inventions Groups (I and IV) and Group IIV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require to have the step of bonding the liner to the front panel wherein the front panel is provided with means to promote bonding to the liner and bonding energy is delivered to the interface between the front panel and the liner. The subcombination has separate utility such as the step of bonding the liner to the front panel wherein the front panel is provided with means to promote bonding to the liner and bonding energy is delivered to the interface between the front panel and the liner.

Inventions Group IV and Group I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require to have the step of providing a carton having a dispensing flap in a side wall and the flap having top and side edges and a liner therein filled with product and sealed. The subcombination has separate utility such as the step of

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providing a carton having a dispensing flap in a side wall and the flap having top and side edges and a liner therein filled with product and sealed.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sameh H. Tawfik whose telephone number is (703) 308-2809. The examiner can normally be reached on Tuesday - Friday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (703) 308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 308-7769 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ST.

February 18, 2003



**EUGENE KIM**  
**PRIMARY EXAMINER**